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11 SOUTH MERIDIAN
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EXAMINER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* KENNETH S. PRICE, WILLIAM J. MCDANIEL,
9 ROGER D. BOWSER, STEVEN E. PETTIT, BRIAN L. WALKER,
10 MARIA R. SWIFT, DAVID S. BUCKNER, and HENRY L. PHILLIPS
11

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13 Appeal 2009-009102
14 Application 09/900,989
15 Technology Center 3600
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18 Decided: November 17, 2010
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21 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
22 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
23 FETTING, *Administrative Patent Judge*.

24 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Kenneth S. Price, William J. Mcdaniel, Roger D. Bowser, Steven E. Pettit, Brian L. Walker, Maria R. Swift, David S. Buckner, and Henry L. Phillips (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 22-42 and 49-52, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a waste processing system and method, and more particularly a waste processing network. Specification 1:8-9.

An understanding of the invention can be derived from a reading of exemplary claims 22 and 39, which are reproduced below [bracketed matter and some paragraphing added].

22. A waste management system, comprising:

[1] a computer storage medium storing waste management data associated with a plurality of vendors having waste management capabilities and providing waste management services and entity profile data associated with a plurality of

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed April 2, 2007) and Reply Brief ("Reply Br.," filed January 12, 2009), and the Examiner's Answer ("Ans.," mailed November 10, 2008), and Final Rejection ("Final Rej.," mailed May 23, 2005).

1 waste producing entities having waste processing requirements
2 and producing waste components; and

3 [2] a first computer system configured to access the
4 computer storage medium and stored waste management data
5 and entity profile data, and further configured to associate a set
6 of vendors from the plurality of vendors to provide waste
7 management service for the waste producing entity.

8

9 39. A waste management method, the method comprising the
10 steps of

11 [1] creating a service network including a plurality of waste
12 processing vendors;

13 [2] evaluating the waste processing capabilities of each of
14 the waste processing vendors in the service network;

15 [3] receiving a waste processing service request from a waste
16 producing entity;

17 [4] comparing the waste processing service request to the
18 capabilities of the waste processing vendors in the service
19 network; and

20 [5] selecting a vendor from the service network to fulfill the
21 waste processing service request.

22

23 The Examiner relies upon the following prior art:

Tipton et al. US 6,097,995 Aug. 1, 2000

Embutsu et al. US 5,699,525 Dec. 16, 1997

24

25 Claims 22-42 and 49-52 stand rejected under 35 U.S.C. § 103(a) as
26 unpatentable over Tipton and Embutsu.

27

DISPOSITION OF THE APPEAL

The Examiner entered a rejection against claims 22-54 under 35 U.S.C. §103(a) as unpatentable over Tipton and Embutsu. Answer 2. The Appellants withdraw claims 43-48 and 53-54 and acknowledge that claims 43-48 and 53-54 are not appealed. App. Br. 2. Accordingly, the appeal as to claims 43-48 and 53-54 stands dismissed.

Upon return of the application to the Examiner, the Examiner should (1) cancel claims 43-48 and 53-54 and (2) notify the Appellants that the appeal as to claims 43-48 and 53-54, is dismissed and claims 43-48 and 53-54 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1214.05, 8th ed., Rev. 7, Jul. 2008.

Given that the appeal as to claims 43-48 and 53-54 stands dismissed, the rejections before us for review are reduced to as follows:

Claims 22-42 and 49-52 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tipton and Embutsu. Answer 3.

ISSUES

The issue of whether the Examiner erred in rejecting claims 22-42 and 49-52 under 35 U.S.C. § 103(a) as unpatentable over Tipton and Embutsu turns on whether Tipton and Embutsu describe associating or selecting waste disposal vendors to a waste producing entity based on a comparison of waste management data to entity profile data and whether Tipton and Embutsu describe the creation of service orders or requests.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Tipton

01. Tipton is directed to systems for the management of hazardous and toxic materials especially chemicals. Tipton 1:7-9. Tipton is concerned with the disposing of chemicals due to the increasing sensitivity to environmental and health issues. Tipton 2:41-43. Tipton describes a comprehensive chemical management system. Tipton 2:61-63. A centralized method requires the close monitoring of the inflow of chemicals and a monitored movement of chemicals from a centralized storage station leading to the eventual close monitored disposal of waste chemicals at a centralized disposal station. Tipton 18:32-45. Chemical containers are labeled with the name of the chemical and all pertinent safety information. Tipton 60:19-21. Waste containers list the waste contents, the date the container became waste, and any hazard warnings associated with the various components of the waste. Tipton 61:7-15. The system further includes contact personnel for any company that a division or department relies on for handling the disposal of their toxic waste. Tipton 49:49-51. The system also supports reports that are preset or set-up by the user. Tipton 41:25-40.

1 *Embutsu*

2 02. Embutsu is directed to an information management apparatus
3 dealing with waste suitable for use in a recycling system which
4 collects discarded home electric appliances and processes them for
5 recycling. Embutsu 1:8-16. Embutsu is concerned environmental
6 problem with discarded home electric appliances. Embutsu 1:19-
7 22.

8 03. The type or kind and quantity of waste stacked in depositories
9 are determined and the waste is then transported to a recycling
10 processor. Embutsu 2:15-21. The type or kind and quantity are
11 input to the management apparatus using a terminal unit.
12 Embutsu 2:9-15. The system further predicts waste generation
13 based on historical data. Embutsu 2:20-35.

14 04. The waste collection region and route are also determined to
15 determine an efficient manner of collecting waste. Embutsu 3:1-8.
16 Discarded home electric appliances are collected by the retailers
17 and waste collecting agents of the recycling system. Embutsu
18 5:22-25. The collection means includes a number of trucks
19 needed based on the quantity of discarded appliances. Embutsu
20 5:26-30. The system uses quantities of appliances to be collected,
21 stockyard information, vacant area, and collection locations to
22 determine the most efficient collection method. Embutsu 6:43-67.

23

ANALYSIS

*Claims 22-42 and 49-52 rejected under 35 U.S.C. § 103(a) as
unpatentable over Tipton and Embutsu*

The Appellants first contend that (1) there is no motivation to combine the cited prior art, the Examiner has failed to point to any section of Tipton, Embutsu, or any other art of record that describes a teaching, motivation, or suggestion to combine the cited prior art, and the Examiner has used improper hindsight reconstruction, as per claims 22 and 49-50. App. Br. 4-8. The Appellants reiterate this argument in support of claims 23-42 and 51-52. App. Br. 10-11, 13-15, 17, and 19.

We disagree with the Appellants. Both Tipton and Embutsu are concerned with the proper disposal of materials in order to protect environmental concerns. FF 01-02. Tipton accomplishes this goal by describing a comprehensive chemical management system that properly labels and disposes chemical waste. FF 01. Embutsu solves this problem by describing a system that efficiently collects waste materials and delivering the waste to recycling centers. FF 03-04. A person with ordinary skill in the art would have recognized to combine Tipton and Embutsu in order to increase the efficiency of disposing materials. As such, Tipton and Embutsu are concerned with the same problem and a person with ordinary skill in the art would have been lead to combine their teachings.

The Appellants further argue that Tipton, Embutsu, or any other art of record fail to describe the motivation asserted by the Examiner. App. Br. 12. However, as discussed in the *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007),

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (‘[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

A person with ordinary skill in the art would have been motivated to combine Tipton and Embutsu in order to increase the efficiency of the disposal materials. This reasoning supports the rationale that a person with ordinary skill in the art would have known to take the creative steps to combine Tipton and Embutsu in order to achieve the specific goal of increasing the efficiency of the disposal materials. As such, a person with ordinary skill in the art would have found it obvious to combine Tipton and Embutsu.

The Appellants further contend that (2) Tipton and Embutsu fail to describe a computer system “configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity” as required by claims 22 and 49-50. App. Br. 8-9. We disagree with the Appellants. Limitation [2] of claim 22 requires associating waste disposal vendors to a waste producing entity. This limitation does not

1 require that the association of the vendor to the waste producing entity to be
2 based on any vendor data or waste producing entity. As such, limitation [2]
3 only requires a link between a vendor and a waste producing entity. Tipton
4 describes a comprehensive chemical management system. FF 01. Tipton
5 further describes the use of chemical containers, which contain content data,
6 and the use of waste containers, which contain waste content data. FF 01.
7 Tipton also describes contact information for any company that a division
8 or department relies on for handling the disposal of their toxic waste. FF 01.
9 That is, Tipton describes an association between a company or vendor that
10 disposes waste and a division or department that produces waste. As such,
11 Tipton describes this broad limitation of claim 22. Embutsu also describes
12 the use of waste collecting agents that collect and dispose of appliances to
13 a recycling processor. Therefore, both Tipton and Embutsu describe this
14 feature of claim 22 and 49-50.

15 The Appellants also contend that (3) Tipton and Embutsu fail to describe
16 the input of any data associated with processing of waste components
17 produced by the waste producing entity, as per claims 23-24, 32, and 27-29.
18 App. Br. 10-11. We disagree with the Appellants. As discussed *supra*,
19 Tipton describes the use of containers and specifically waste containers.
20 FF 01. The waste containers list the waste contents, the date the container
21 became waste, and any hazard warnings associated with the various
22 components of the waste. FF 01. This data is directly used in the processing
23 of the waste. As such, Tipton describes the input of data associated with the
24 processing of waste components produced by the waste producing entity.

25 The Appellants additionally contend that (4) Tipton and Embutsu fail to
26 describe the creation of waste processing service orders or service requests

1 by a waste producing entity and further fails to describe any direct
2 interaction with a vendor by the inventory system, as per claims 25, 34-35,
3 39-42, and 51-52. App. Br. 11-12. We agree with the Appellants. As
4 discussed *supra*, Tipton generally describes a chemical management system
5 that includes features for the disposal of content and Embutsu describes a
6 home electric appliance disposal system. FF 01-02. However, Tipton and
7 Embutsu fail to describe a waste processing service request or service order
8 and further fails to describe any direct interaction with a vendor by the
9 inventory system.

10 The Examiner argues that Tipton describes that a user can click on an
11 item to cause an action and the user can further click on a transfer command
12 line and these features are the same as creating a waste processing service
13 order or service request. Ans. 10. However, the ability to cause an action or
14 transfer data is not the same as creating a service request or service order.
15 We do not see any connection between clicking on an item to cause an
16 action or clicking on a transfer command line and the creation of a service
17 request or a service order. The Examiner has failed to provide any further
18 rationale as to how these features are the same.

19 The Examiner further argues that it would have been obvious to modify
20 Tipton to show a waste producing entity creating a waste processing service
21 order or request because Tipton teaches the monitoring of chemicals
22 throughout a system at various inflow and outflow stations. Ans. 10. While
23 we agree Tipton describes the monitoring of chemicals at various inflow and
24 outflow stations (FF 01), we disagree that a person of ordinary skill in the art
25 would have taken the creative steps to create a waste processing service
26 order or request by merely monitoring the flow of chemicals. The

1 monitoring of the flow of chemicals does not suggest the monitoring of
2 waste, much less the creation of a waste processing service request or order.
3 As such, Tipton and Embutsu fail to describe these features.

4 The Appellants further contend that (5) Tipton and Embutsu fail to
5 describe any comparison or analysis with regard to vendors for waste
6 management service for the waste producing entity, as per claims 26 and 33.

7 We agree with the Appellants. As we noted *supra*, claim 22 only
8 required an association between a waste disposal vendor and a waste
9 producing entity and did not impose any further requirements on what the
10 association is based on. Claims 26 and 33 impose this further limitation and
11 require that vendors are selected based on vendor capabilities and entity
12 profile data.

13 Tipton only describes contact information for a company that a
14 department or division relies on for waste disposal, i.e. a general association
15 between a disposal vendor and a waste producer; however, Tipton fails to
16 describe that the selection of the vendor is based on a comparison of the
17 waste management data to entity profile data.

18 Embutsu also fails to describe selecting a collection agent based on the
19 agent's capabilities compared to the disposal demand. The Examiner argues
20 that it would have been obvious to modify Tipton to include this feature
21 because each station may have a unique structure equipped to handle certain
22 chemicals. Ans. 11.

23 However, we find no such description in Tipton and the Examiner has
24 failed to provide a citation for such a description. As such, Tipton and
25 Embutsu fail to describe this feature of claims 26 and 33.

1 The Appellants also contend that (6) Tipton and Embutsu fail to describe
2 claims 30-31 and 36. App. Br. 16-18. We agree with the Appellants.
3 Claims 30-31 recite the generation of a service request. Claim 36
4 incorporates the generation of a service request from claims 34-35. We
5 found Tipton and Embutsu fail to describe this feature *supra* and fail to
6 describe this feature as recited in claims 30-31 and 36 for the same reasons.
7 Since this issue is dispositive as to the rejection against these claims, we
8 need not reach the remaining arguments raise by the Appellants against these
9 rejections.

10 The Appellants additionally contend that (7) Tipton and Embutsu fail
11 to describe any reports related to waste management vendors and any
12 interaction between the inventory system and vendors of waste management
13 services, as per claims 37-38. App. Br. 20-21.

14 We agree with the Appellants. Claims 37-38 require the generation of a
15 financial statement relating to the services provided by the vendors to the
16 waste producing entity. Tipton and Embutsu fail to describe a consolidated
17 financial statement relating to the waste management services provided by
18 the vendors to the waste producing entity.

19 The Examiner found that Tipton describes the generation of reports and
20 suggests financial statements because statements may indicate the total
21 processing cost of waste chemicals for an institution, or the cost per division
22 and department. Ans. 12. However, claims 37-38 require a financial
23 statement *relating to the services provided by the vendors to the waste*
24 *producing entity*. The Examiner's assertion only suggests the processing

1 costs of the waste producing entity and is not related to the services provided
2 by the vendors. As such, the Examiner's finding is not found to be correct.

3

4

CONCLUSIONS OF LAW

5 The Examiner did not err in rejecting claims 22-24, 27-29, 32, and 49-50
6 under 35 U.S.C. § 103(a) as unpatentable over Tipton and Embutsu.

7 The Examiner erred in rejecting claims 25-26, 30-31, 33-42, and 51-52
8 under 35 U.S.C. § 103(a) as unpatentable over Tipton and Embutsu.

9

DECISION

10 To summarize, our decision is as follows.

- 11 • The rejection of claims 22-24, 27-29, 32, and 49-50 under 35 U.S.C.
12 § 103(a) as unpatentable over Tipton and Embutsu is sustained.
- 13 • The rejection of claims 25-26, 30-31, 33-42, and 51-52 under
14 35 U.S.C. § 103(a) as unpatentable over Tipton and Embutsu is not
15 sustained.
- 16 • Upon return of the application to the Examiner, the Examiner should
17 (1) cancel claims 43-48 and 53-54 and (2) notify the Appellants that
18 the appeal as to claims 43-48 and 53-54, is dismissed and claims 43-
19 48 and 53-54 are cancelled.

